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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,139	05/02/2002	Martin Williges	1898	8216

7590 02/13/2004
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EXAMINER

FORD, JOHN K

ART UNIT PAPER NUMBER

3753

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,139

Examiner

FORD

Applicant(s)

Williges

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3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 7
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

The Examiner is doing a routine name search on inventor Williges turned up SN 09/913,247 (US 2002/0121618 A1) which appears to be highly relevant to the present application. Please cite here any relevant prior art cited in the prosecution of that application. If there are other related applications that the Examiner should be aware of make them of record in response to this action.

Applicant's Abstract must be rewritten as one paragraph of 250 words or less.

This application contains claims directed to the following patentably distinct species of the claimed invention: first species wherein temperature TMA is measured at the outlet 36 of the bypass line 22 (page 8, line 6), second species wherein TMA is measured at the outlet of the engine 12 (page 8, lines 6-7) and third species wherein TMA is measured at the control valve 26 (page 8, line 7).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the additional temperature at the outlet 36 of the bypass 22 disclosed on pages 7, lines 25-27 ^{must be} ~~is not~~ shown. The subject matter of claim 12 is also not shown namely the multiple heat sources and /or sinks must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after

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the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

The disclosure is objected to because of the following informalities: applicant's statement of the prior art on page 1, line 5 of the specification is unclear. Claim 1, as currently written, has no easily discernible preamble. Please rewrite the exact description of what is conceded prior art into the specification at page 1, line 5. On page 7, line 22-27, applicant states that temperature sensor 32 measures a temperature approximately the same as the temperature at outlet 36. This is clearly incorrect as sensor 32 measures the temperature at the outlet of the engine. On page 9, line 7 "52" should read --62 --.

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 3-4. "Can be electrically triggered" is vague language. Since a specific control Function is recited here the Examiner would suggest amending the quoted language to read -- is controlled by a control means --. In claim 5, line 1 and 2, the Examiner would suggest changing "the first" and "the second" to -- a first -- and -- a second --, respectively.

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Claim 13 is an impermissible claim under U.S. practice. Dependent claims cannot subtract structure from independent claims even if they intend to substitute other structure.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 11 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no enabling disclosure in the specification to support what is claimed in claim 7. No control disclosure is given for what the system actually does in the event of a malfunction or even how a malfunction is detected. No disclosure exists for which additional sensors are used or how they are used. The disclosure, at best, discloses the idea of a malfunction detector but provides no enabling disclosure for how to construct one in applicant's disclosed system. The same criticism applies to claim 11, where the phrase "proper functioning" is treated by the Examiner's as simply another way of expressing the idea of detecting a malfunction.

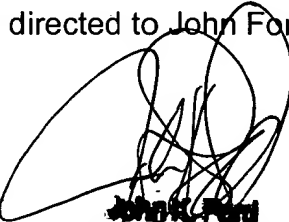
Claim 13 is not enabled to the extent that it uses the words "and/or". These alternatives are clearly disclosed as alternatives (i.e. with the word "or") on page 8, lines 6-7. No enabling disclosure exists to process more than one of them in the formula found on page 8, line 4 of the specification.

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The most expedient course of action to respond to these latter rejections is to cancel claims 7 and 11. Claim 13 must be amended so that "and/or" is changed to – or – and it must somehow be incorporated into claim 1 in such a way that it does not take away structure from claim 1. The examiner would suggest defining an equation using the variable TMA in claim 1 (see page 8, line 4) and then specifying that TMA can be any one of the three temperatures listed on page 8, lines 6-7 of the specification.

Any inquiry concerning this communication should be directed to John Ford at telephone number 308-2636.

Ford/DI
February 9, 2004



John K. Ford
Primary Examiner